

Application Serial No. 10/523,566  
Reply to Office Action of May 23, 2007

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Docket: CU-4079

### REMARKS

In the Office Action, dated May 23, 2007, the Examiner states that Claims 1-11 are pending and Claims 1-11 are rejected. By the present Amendment, Applicant amends the Claims 1, 2 and 5-11 and adds new Claims 12 and 13.

In the Office Action, Claims 5-9 and 11 are objected to as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Claims 5-9 and 11 have been amended to depend from Claim 1, and therefore, the objections for improper multiple dependencies should be overcome.

In the Office Action, Claims 8-11 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 8-11 are also rejected under 35 U.S.C. § 101 because the claims are method claims but do not recite any method steps. The Applicant has amended Claims 8-11 to include method steps, and therefore, the current 35 U.S.C. § 112 and 35 U.S.C. § 101 rejections should be deemed overcome.

In the Office Action, Claims 1-9 and 11 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application no. 11/048,573 in view of the Campbell (U.S. 5,415,792). Claims 1-9 and 11 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application no. 11/048,441 in view of the Campbell. Claims 1-9 and 11 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application no. 11/462,340 in view of Campbell. Claim 10 is provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over the claims 1-12 of copending Application no. 11/048,573 in view of the Campbell and in further view of Curtis (U.S. Pub No. 2003/0220209). Claim 10 is provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over the claims 1-12 of copending Application no. 11/048,441 in view of the Campbell and in further view of Curtis. Claim 10 is provisionally rejected on the grounds of nonstatutory obviousness-type double

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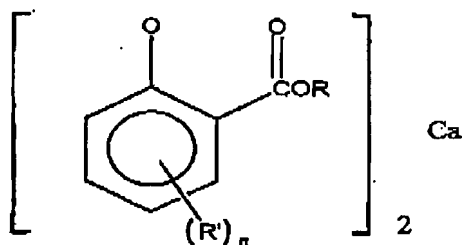
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patenting as being unpatentable over the claims 1-12 of copending Application no. 11/462,340 in view of the Campbell and in further view of Curtis.

The Applicant has submitted a terminal disclaimer with this response to overcome the double patenting rejections, and therefore, the rejections should be withdrawn.

In the Office Action, Claims 1-2, 5, 8-9, and 11 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Campbell. Claims 1-2, 5, 8-9, and 11 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell. Claims 3-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell in view of Chambard (U.S. Pub. No. 2002/0082176). Claims 6-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell in view of Papay (U.S. 5,652,201). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell in view of Curtis (U.S. 2003/0220209).

The Applicant respectfully disagrees with and transverses the other rejections based on Campbell. The "salicylate", represented in the present by chemical formulas (1) and (2), in the present invention is completely different than the "overbased alkylated alkyl salicylate" in Campbell. In the present invention, the salicylate, represented by chemical formulas (1) and (2), are salts of a carboxyl group of alkyl salicylic acid and alkaline (alkaline earth) metal. In contrast, the salicylate disclosed in Campbell is the compound represented by the chemical formula below where the hydroxyl group and the alkaline earth metal are bonded.



Therefore, the salicylate that is claimed in the present invention is different from that disclosed in Campbell.

More specifically, in the salicylate of Campbell, the carboxyl group forms an ester with an alkyl group of from 1 to 6 carbon atoms (column 3, line 31). The ester is referred to as "alkylated alkyl salicylate." Campbell discloses, in column 1, line 67

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through column 2, line 8, "alkylated alkyl salicylates can be overbased without hydrolysis of the ester functionality to provide for overbased lubricating oil additives suitable for use in lubricating oil compositions. This discovery is particularly surprising in view of the fact that the overbased products of this invention lack carboxyl (-COOH) functionality but, rather, possess an ester (-COOR) functionality (R being alkyl of from 1 to 6 carbon atoms)." Additionally, Campbell discloses in column 4, lines 62-66, "I believe that the alkaline earth metal base is incorporated through the hydroxyl group of the salicylate. In Example 4 of Campbell, it describes that in the preparation of overbased alkyl methyl salicylate "proton nuclear magnetic resonance spectroscopy (H-nmr) and infrared spectroscopy of the resulting composition indicated the retention of the methyl ester in the overbased product." (column 9, line 33-36). Thus, Campbell does not disclose that which is claimed in the present invention, because Campbell does not disclose a salicylate which is a salt of a carboxyl group of alkyl salicylic acid and an alkaline (alkaline earth) metal.

Moreover, unlike the present invention where the position of the alkyl substituent of the salicylate specified as (A) is claimed as 3- and 5- disubstituted, Campbell does not disclose the position of the alkyl substituent of the salicylate.

Additionally, the salicylate (B) in the present invention has specified secondary alkyl substituent having 10 or more and less than 20 carbon atoms. Campbell discloses the carbon number of the alkyl substituent of the salicylate as being about 15 to about 50, but it does not disclose the structure of the alkyl substituent as being linear or branched.

Therefore, because the structure of salicylate claimed in the present invention is different from that disclosed in Campbell, the present invention is not anticipated by or obvious to Campbell.

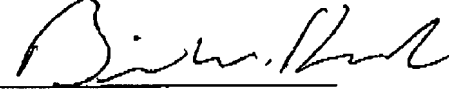
Further, the Applicant has amended independent Claim 1 to recite "(A) and/or (B) incorporated into the base oil in an amount of 0.005 to 0.5% by mass of the total of the composition". Therefore, the current amendment overcomes the rejection to Campbell because that reference discloses the salicylate can be used in a concentrate comprising from 5 to 95% by weight of salicylate. Moreover, all the rejections to the claims should be deemed overcome because the claims all depend from amended independent Claim 1.

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In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,



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Date

Attorney for Applicant  
Brian W. Hameder  
c/o Ladas & Parry LLP  
224 South Michigan Avenue  
Chicago, Illinois 60604  
(312) 427-1300  
Reg. No. 45613